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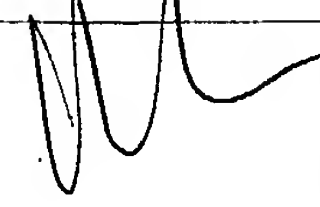
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| APPLICATION NO.                                                                | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/646,197                                                                     | 08/22/2003  | John D. Santi        | 018367-9819-00      | 9046             |
| 23409                                                                          | 7590        | 12/08/2004           | EXAMINER            |                  |
| MICHAEL BEST & FRIEDRICH, LLP<br>100 E WISCONSIN AVENUE<br>MILWAUKEE, WI 53202 |             |                      | CHANG, CHING        |                  |
|                                                                                |             |                      | ART UNIT            | PAPER NUMBER     |
|                                                                                |             |                      | 3748                |                  |

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                                                                                                   |  |
|------------------------------|------------------------|---------------------------------------------------------------------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b>                                                                               |  |
|                              | 10/646,197             | SANTI, JOHN D.  |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>                                                                                   |  |
|                              | Ching Chang            | 3748                                                                                              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-19, 21-28 and 31-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22-28 and 31-35 is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-19, and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

This Office action is in response to the amendment filed on September 30, 2004.

### ***Claim Objections***

1. Claims 18 and 21 are objected to because of the following informalities:
  - " the follower arm " in claims 18 and 21 appears to be – a follower arm --.
  - " the second aperture " in claim 18 appears to be -- a second aperture --Appropriate corrections are required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-7, 9-19, and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

More specifically, " and second stop in contact with the valve arm " in claim 1 is new matter.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. ***Claims 1-3, 5-6, 12-16, 18, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Bonde et al. (US Patent 6,672,269).***

Bonde discloses a valve-operating lever (460) comprising: a valve arm (350) including a first aperture defining a valve arm engagement portion (to allow an unlabeled part through the middle of 350, See Fig. 8); a connector member (340, and the unlabeled parts connecting 350 and 340 in Fig. 8); a first stop cooperating with the connector member to at least partially define a first engagement portion, the valve arm engagement portion engaging the first engagement portion; and a second stop (the

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contact between 350 and 340) positioned such that the valve arm is sandwiched between the first stop and the second stop, the first stop and second stop in contact with the valve arm to inhibit movement of the valve arm along a longitudinal axis defined by the connector member; wherein the first aperture is substantially circular; wherein the connector member includes a cylindrical tube (See Fig. 8); wherein the valve arm defines a valve arm thickness and wherein the first engagement portion defines an axial length that is at least as great as the valve arm thickness (See Fig. 8); wherein the valve arm is formed from a stamped metal; wherein the first stop is integrally formed as part of the connector member; wherein the second stop is integrally formed as part of the connector member; wherein the first stop and the second stop overlay a portion of the valve arm; wherein the connector member includes a third stop (the contact between 340 and 470), the connector member and the third stop cooperating to define a second engagement portion; wherein the third stop is integrally formed as part of the connector member; wherein a follower arm (470) defines a follower arm thickness, and the second engagement portion defines an axial length that is at least as great as the follower arm thickness.

In addition, when a product by process claim, claim 6 of this instant application is rejected over a prior art product such as that shown in Bonde reference, which appears to be identical, although produced by a different process, the burden is upon the applicants to come forward with evidence establishing an unobvious difference between the two. See *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. ***Claims 4 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonde et al. (as applied to claims 1, 15/13/12/1 above) in view of Okubo et al. (US Patent 6,199,527).***

Bonde discloses the invention, however, fails to disclose the said stops including a reduced-diameter portion that defines a shoulder.

The patent to Okubo on the other hand, teaches that it is conventional in the cam follower art, to have utilized a pivot (115) having stops including a reduced-diameter portion that defines a shoulder (See Fig. 12B).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized the stops including a reduced-diameter portion that defines a shoulder as taught by Okubo in the Bonde device, since the use thereof would provide an improved valve actuator assembly, with better connections among its components.

8. ***Claims 7 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonde et al. (as applied to claims 1, 15/13/12/1 above) in view of Zubeck (US Patent No. 6,550,435).***

Bonde discloses the invention, however, fails to disclose the said engagement portions having knurls.

The patent to Zubeck on the other hand, teaches that it is conventional in the art of a roller finger follower assembly, to utilize knurls on the engagement surfaces to press fit cams (48) into a lash pin (36).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized knurls on the engagement surfaces as taught by Zubeck in the Bonde device, since the use thereof would provide more effective firm connections among the components of a valve actuator assembly.

9. ***Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonde et al. (as applied to claim 1) in view of Gracyalny et al. (US Patent 6,349,688).***

Bonde further discloses the said system comprising a follower arm (470), wherein the follower arm includes a follower surface adapted to engage a cam surface (360); wherein the valve arm includes a valve actuating portion adapted to actuate a valve (250) in response to movement of the follower arm.

Bonde, however, fails to disclose the said follower arm including a second aperture.



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The patent to Gracyalny on the other hand, teaches that it is conventional in the art of an overhead valve lever assembly, to utilize a follower arm (168) having an aperture (184) to define a follower arm engagement portion (180).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized the aperture as taught by Gracyalny in the Bonde device, since the use thereof would provide more effective connections among the components of a valve actuator assembly.

#### ***Allowable Subject Matter***

10. Claims 22-28, and 31-35 are allowed.

#### ***Response to Arguments***

11. Applicant's arguments with respect to claim have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within



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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ching Chang whose telephone number is (571)272-4857. The examiner can normally be reached on M-Th, 7:00 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Denion can be reached on (571)272-4859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

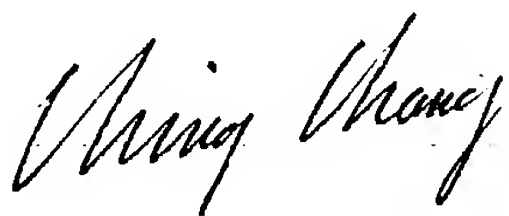
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Patent Examiner



Ching Chang



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SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700